REMARKS

This response is a Preliminary Amendment being filed with a Request for Continued Examination. In the Office Action mailed April 1, 2008, the Examiner provisionally rejects claim 1 on the ground of nonstatutory obviousness-type double patenting as being unpatenable over claims 1 of US Patent Application Serial No. 10/752,761. The Examiner further objects to figures 8d based upon an informality. Claims 1, 2, 4, 8 through 12, 14, 18 through 22, 24 and 28 through 30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,757,707 to Houghton, et al. ("Houghton"). Claims 3, 7, 13, 17, 23 and 27 are rejected under 35 U.S.C. § 103(a) as obvious over Houghton in view of US Patent Publication No. 2004/0091236 A1 to Boston, et al. ("Boston"). Claims 5, 15, 16, 25 and 26 are rejected under 35 U.S.C. § 103(a) as obvious over Houghton in view of Boston and in further view of U.S. Patent No. 6,813,639 to Nobakht, et al. ("Nobakht").

An Information Disclosure Statement of references associated with co-pending patent applications is being submitted herewith.

Claims 1 through 9, 11 through 19 and 21 through 29 are currently pending in the present application, with claims 1, 11 and 21 being independent claims. By way of the present Response, Applicants hereby amend claims 1, 2, 11, 12, 21 and 22. No new matter has been added and the amendments are supported by the specification as originally filed. For at least the reasons set forth below, Applicants respectfully submit that all pending claims are allowable and respectfully request withdrawal of the rejection of claims 1 through 9, 11 through 19 and 21 through 29.

The pending claims have been amended to further emphasize the distinctions outlined by Applicants' representatives in an in-person interview. More specifically, the claims have been amended to note the architectural distinctions of bi-directional and uni-directional

communication networks. The user computer interfaces across a bi-directional network (e.g. the Internet) and the broadcast-based client-side device (e.g. set top box) receives the broadcast and preference information in a push format using a uni-directional communication technique. This overcomes prior art limitations relating to uni-directional broadcast formatting, which did not allow for set-top box based interaction with a backend computing system, but rather overcomes these limitations by a secondary user interface (the user computer interface) to set these preferences.

The Examiner rejects pending claim 1 under the judicially created doctrine of double patenting over claim 1 of US Patent Application Serial No. 10/752,761. Applicants note that a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(c) was previously filed on January 7, 2008 with proper filing fees in order to obviate the provisional rejection. In view thereof, Applicants respectfully request withdrawal of the nonstatutory obviousness-type double patenting of claim 1.

The Examiner objects to figure 8d to on the basis of an informality. Accordingly, the Examiner requires new corrected drawings in compliance with 37 CFR 1.1.21(d). In response, Applicants submit replacement figure 8d. In view thereof, withdrawal of the objection is respectfully requested.

The Examiner rejects claims 1, 2, 4, 8 through 12, 14, 18 through 22, 24 and 28 through 30 under 35 U.S.C. § 102(e) as being anticipated by Houghton. Independent claim 1, as currently amended, is directed to a system comprising a user computer, coupled to a data network, to display a user interface usable to enter a plurality of user preferences and transmit said plurality of user preferences to the bi-directional communication data network. The system further comprises a server coupled to the data network to receive said plurality of user preferences from said user computer and to generate non-broadcast content based on said plurality of user

preferences. A broadcast-based client-side device, coupled to the uni-directional and bi-directional network, is to receive broadcast programming content from a broadcast source and said non-broadcast content from said server and is to display said non-broadcast content and said broadcast programming content on a display of said broadcast-based client-side device. The non-broadcast content is displayed in accordance with said plurality of user preferences and includes overlay data to display one or more overlays on said display in conjunction with said broadcast programming content, said one or more overlays selected by a user from a list of overlays prior to being displayed in conjunction with said broadcast programming content. Independent claims 11 and 21 are directed to a method and a computer system, respectively, which comprise substantially similar elements to those comprising independent claim 1.

First off, Applicants note, consistent with the in-person interview, that the prior art asserted herein relates to a completely different architecture, the bi-directional only communication architecture. The prior art uses either the computer itself as the broadcast-based client side device or provides for interactivity in the set top box. None of the asserted prior art teaches or suggests the explicitly claimed architecture of the bi-directional user interface communication **and** the uni-directional broadcast communication, which thereby renders the present pending claims allowable over the prior art of record. Rather, the prior art teaches the bi-directional communication techniques through the set top box, using the "web-based" TV system as described below, which is in contrast to the separation of the claimed "user computer" and "broadcast-based client-side device" as claimed herein.

Houghton discusses a web-based TV system that incorporates a computer-implemented method of displaying related sources of viewing content and includes receiving a user input specifying a URL address corresponding to a web page, determining a corresponding television channel and displaying the corresponding television channel. (Houghton, Col. 3, Lines

40-46). Houghton fails to teach or suggest all of the claim elements of independent claim 1, as currently amended. Specifically, Houghton fails to teach or suggest the claim element "a user computer, coupled to a bi-directional communication data network, to display a user interface usable to enter a plurality of user preferences and transmit said plurality of user preferences to said data network."

In rejecting the claim element, the Examiner points to Houghton's discussion regarding a set top device, which is described as a general purpose computer that includes a television tuner and can display two different sources of content, broadcast television programming and non-broadcast web content. (Houghton, Col. 2, lines 15-30). The Examiner's reliance on Houghton's set top device, however, fails to disclose the user computer that displays the user interface of the present invention, but instead highlights the architectural difference between the web-based TV system disclosed in Houghton and system of the presently claimed invention. The set top device disclosed in Houghton only receives content; it is in essence a one-way directional device. This is further evidenced by the Houghton's discussion regarding information feeds upon which the Examiner relies upon in order to evidence specialized content. Houghton discloses information feeds in which content related to a subject matter selected for viewing by the user is displayed to the user, the related content including "information relating to a television channel available to a user but one which a user has not subscribed to . . . [but] . . . may be enticed to". (Houghton, Col. 5, lines 5 -15). Houghton further discusses "a distribution channel for Internet-TV providers and broadcast TV providers to distribute interactive content and advertising . . . [and] enable offerings, such as information feeds, tickers, polling, contextual chats, targeted advertisements, instant Record/Remind functions, tags, games, and shopping." (Houghton, Col. 5, lines 17 -27).

However, this simply supports the notion that the system disclosed in Houghton is directed to solely receiving content and not to first entering user preferences, transmitting those preferences and subsequently receiving content in accordance with those preferences. The "user computer, coupled to a data network, to display a user interface usable to enter a plurality of user preferences and transmit said plurality of user preferences to bi-directional communication data network" of the presently claimed invention is, therefore, a two-way device in which the user interface displayed on the user computer both receives user preferences entered into the user interface and transmits the user preferences to the data network in order to customize the non-broadcast content that will be subsequently displayed.

Furthermore, Houghton fails to discloses the claim element of independent claim 1, "wherein said non-broadcast content . . . includes overlay data to display one or more overlays on said display in conjunction with said broadcast programming content, said one or more overlays selected by a user from a list of overlays prior to being displayed in conjunction with said broadcast programming content." In support of the rejection, the Examiner points to Houghton's teaching that the "programming may by leveraged because the system and techniques enable related offerings, such as information feeds, tickers, polling, contextual chats, targeted advertisements, instant Record/Remind functions, tags, games, and shopping." (Houghton, Col. 5, lines 23-26), asserting that information feeds, such as a URL, are selected from a list of URLs. However, the information feeds, tickers, polling, contextual chats, targeted advertisements, instant Record/Remind functions, tags, games, and shopping are simply a listing of related offerings and do not teach "one or more overlays selected by a user from a list of overlays prior to being displayed in conjunction with said broadcast programming content"

In support of the rejection, the Examiner further relies upon Houghton's disclosure with respect to Figure 9, "When the user selects the URL address associated with the

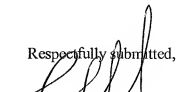
screen content 630, software or hardware in the set-top box 627 compares the requested URL address to a list of channels mapped to that address to determine if the primary complementary channel is available and subscribed." (Houghton. Col. 8, ll. 46-48). Figure 9 in Houghton illustrates a listing of URLs, for example, for soon to be released movies, along with the video broadcast content. The Examiner asserts that the user selects a URL feed from a list on a content page such as shown in Fig. 9, which is an overlay, and the selection of the URL also triggers another overlay to appear on the content page. (Office Action, 4/1/2008, pg. 7). However, Houghton solely teaches providing a list of URLs that a user can select as he is watching a broadcast - this is not the same as selecting one or more overlays from a list of URLs that is used for display with broadcasting content. At best, Houghton here teaches displaying overlay data with broadcasting content without a previous determination by the user as to what type of overlay data (i.e. overlay) is to be displayed.

Applicants have conducted a thorough review of both Houghton and respectfully assert that Houghton, considered alone or in combination with the prior art of record, does not teach or suggest at least "a user computer, coupled to a data network, to display a user interface usable to enter a plurality of user preferences and transmit said plurality of user preferences to said data network" or a "a broadcast-based client-side device, . . . to display said non-broadcast content and said broadcast programming content on a display of said broadcast-based client-side device, and wherein said non-broadcast content is displayed in accordance with said plurality of user preferences and includes overlay data to display one or more overlays on said display in conjunction with said broadcast programming content, said one or more overlays selected by a user from a list of overlays prior to being displayed in conjunction with said broadcast programming content." Accordingly, Applicants respectfully request withdrawal of the rejection of independent claims 1, 11 and 21 and allowance of the same

The dependent claims of the present application contain additional features that further substantially distinguish the invention of the present application over Houghton, Hassell and the prior art of record. Given the Applicants' position on the patentability of the independent claims, however, it is not deemed necessary at this point to delineate such distinctions.

For at least all of the above reasons, Applicants respectfully request that the Examiner withdraw all rejections, and allowance of all the pending claims is respectfully solicited. To expedite prosecution of this application to allowance, the Examiner is invited to call the Applicants' undersigned representative to discuss any issues relating to this application.

Respectfully submitted,



Dated: July 1, 2008

THIS CORRESPONDENCE IS BEING SUBMITTED ELECTRONICALLY THROUGH THE PATENT AND TRADEMARK OFFICE EFS FILING SYSTEM ON JULY 1, 2008.

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